

the documents are in a predetermined order and orientation. Finally, the processed documents are automatically sorted into one of numerous output bins based on different criteria.

The point of all of the automation in Stevens '273 is to quickly and efficiently handle large quantities of mail. In fact, the system in the Stevens '273 patent processes mail at 10,000 envelopes per hour. That is almost three envelopes every second.

The Official Action appears to recognize that nothing in Stevens '273 teaches or suggests stopping an envelope along an extractor to present the contents for manual extraction by an operator. To fill the shortcoming, the Official Action relies upon Miller '169, which teaches a semi-automated machine in which envelopes are stopped at an extractor so that an operator can manually extract the documents from the envelopes.

The problem with the suggested combination is that there is no teaching or suggestion to make such a combination. The Official Action states that the motivation to combine the selected pieces from Stevens and Miller is that removing the automated extractor in Stevens and replacing it with a manual extractor would save capital cost associated with the automated extractor and provide a reliable approach to document removal. There are several critical flaws with this motivation.

First, replacing the automated extractor in Stevens with a manual extractor would reduce the speed of the entire system to the rate of the manual operation. As mentioned above, the system in Stevens can process envelopes at a rate of almost three envelopes every second. To maintain that rate, the slowest process in the system must operate at a rate of three envelopes per second. If the automated extractor in Stevens '273 is replaced with a manual extraction process the

whole system would be brought to a screeching halt.

Each envelope would be held at the extractor until the operator removes the documents. The operator would then need to re-feed the documents back into the system so that the rest of the processing can be accomplished. In such a system the mail would back-up at a staggering rate.

Upstream from the manual extractor, the automated detection station and opener would be processing envelopes at a high rate, but the envelope would simply pile up in front of the operator. Downstream from the manual extractor the automated scanning, re-ordering, re-orienting and sorting would process the documents but the downstream systems would have massive over-capacity because a manual operator could never keep up with the down stream systems.

Combining Stevens '273 system with a manual extractor would be like removing the motor out of a top fuel drag car and pulling the dragster by a horse because horses don't break down as often as drag car motors. Could you do it? Yes. But it would be a complete waste of the drag care's systems. There would be no need for an air-shifted 5-speed transmission, a chrome molly 12-point roll cage or triple parachutes to slow the car down.

Just because there is a good reason to pull a carriage by a horse does not mean there is a good reason to pull a drag car by horse. Why would you spend all of the expense on the systems that are designed for high speed if you are not going to race at high speed? In the same way, there would be no point to using a manual extractor in the Stevens '273 system because it would be a waste of all the other components that are designed to go fast.

Furthermore, the references do not provide any motivation to make the

combination suggested in the Official Action. The Federal Circuit has repeatedly emphasized that the motivation to combine references must come from the references. It is improper to simply imagine a potential motivation to combine pieces of certain references and then combine the references. Doing so is simply using the Applicants' disclosure as a roadmap.

Of course, there is no suggestion in the references to combine the pieces as suggested in the Official Action because it would not make any sense, as discussed above. In fact, it would be contrary to the teaching of Stevens '273, which is directed to increasing the speed and automation of a system, and the suggested combination would do the opposite.

In response to Applicants' previous remarks, the Official Action states that the systems in Stevens '273 certainly break down at times and there would be a need to have tasks performed by hand. Making a transport system so that documents can be removed in case of a jam or break down is not the same as making an extractor that is operable to open envelopes and present the contents to an operator for manual removal.

In light of the foregoing, Applicants request that the Examiner reconsider the rejection of claims 1-23. In addition, Applicants request that the Examiner favorably consider newly presented claims 24-60.

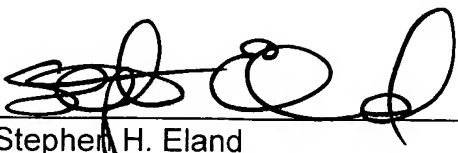
The Examiner is encouraged to contact Applicants' undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN

Patent Application No. 10/007,317

A Professional Corporation
Attorneys for Applicant(s)

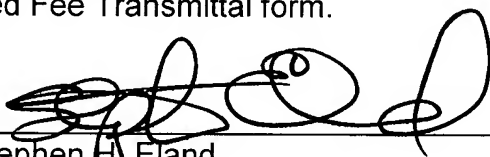
By 
Stephen H. Eland
PTO Registration No. 41,010

Telephone: (215) 563-4100
Facsimile: (215) 563-4044

Petition for Extension Under 37 CFR §1.136(a)

Applicant's undersigned Attorney hereby petitions for an extension of time of **Three** months beyond the time period set in the last office communication. The proper fee is enclosed as identified in the enclosed Fee Transmittal form.

October 21, 2004
Date of Certificate


Stephen H. Eland
PTO Registration No. 41,010